APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,686	03/30/2004	Gregory Rombola	H10332-1/JDP	4012

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EXAMINER
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ART UNIT	PAPER NUMBER
2625	

MAIL DATE	DELIVERY MODE
12/11/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 April 2008</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-29</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-29</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsukubo et al

(Pub. No.: US 20030038952)

Regarding claim 1, 8, 14 Matsukubo et al disclose: A method of printing an image (note page 2,

paragraphs 0012&0025) comprising the steps of: converting the image into a digital bitmap (note

page 2, paragraph 0027) comprised of an array of pixels wherein each pixel is assigned a digital

value representing marking information (note page 2, paragraph 0027-0028, and page 5,

paragraph 0122) defining each pixel as either a background pixel, interior pixel, or an edge pixel

(note page 2, paragraphs 0043-0046 and page 5, paragraph 0122, and page 9, paragraph 0201)

and, reassigning the digital value of one or more edge pixels or interior pixels to lower values

independently in order to reduce toner consumption of the printer (note page 5, paragraphs 0125-

0129).

Regarding claim 2 Matsukubo et al disclose: A method in accordance with claim 1, wherein the

converting step comprises converting the image to a binary digital bitmap and the reassigning

step comprises reassigning the binary digital values to multi-bit digital values (note page 5,

paragraphs 0119-0121).

Regarding claim 3 Matsukubo et al disclose: A method in accordance with claim 1, wherein the converting step comprises converting the image to a multi-bit digital bitmap and the reassigning step comprises reassigning the binary digital values to multi-bit digital values (note page 5, paragraphs 0119-0121).

Regarding claim 4 Matsukubo et al disclose: A method in accordance with claim 1, wherein the reassigning step comprises increasing the value of edge pixels with respect to interior pixels (note page 5, paragraph 0128).

Regarding claim 5 Matsukubo et al disclose: A method in accordance with claim 1, wherein the reassigning step comprises decreasing the value of edge pixels with respect to interior pixels (note page 5, paragraphs 0127&0129).

Regarding claim 6 Matsukubo et al disclose: A method in accordance with claim 1, further comprising performing the defining and reassigning steps two or more times (note page 5, paragraphs 0126-0128).

Regarding claim 7 and 15 Matsukubo et al disclose: A method in accordance with claim 1, wherein the reassigning step comprises reassigning multiple interior pixel values (note page 5, paragraph 0127, 0129).

Regarding claim 9 Matsukubo et al disclose: A method in accordance with claim 8, wherein the converting step comprises converting the image to a binary digital bitmap and the reassigning step comprises reassigning the binary digital values to multi-bit digital values (note page 5, paragraphs 0119-0121).

Regarding claim 10 Matsukubo et al disclose: A method in accordance with claim 8, wherein the converting step comprises converting the image to a multi-bit digital bitmap and the

reassigning step comprises reassigning the binary digital values to multi-bit digital values (note

page 5, paragraphs 0119-0121).

Regarding claim 11 Matsukubo et al disclose: A method in accordance with claim 8, wherein

the reassigning step comprises increasing the value of edge pixels with respect to interior pixels

(note page 9, paragraph 0201 and page 5, paragraphs 0127&0129).

Regarding claim 12 Matsukubo et al disclose: A method in accordance with claim 8, wherein

the reassigning step comprises decreasing the value of edge pixels with respect to interior pixels

(note page 9, paragraph 0201).

Regarding claim 13 Matsukubo et al disclose: A method in accordance with claim 8, further

comprising performing the defining and reassigning steps two or more times (note page 5,

paragraphs 0126-0128).

Regarding claim 16 Matsukubo et al disclose: An apparatus for altering the appearance of an

image printed by a printer (note page 5, paragraph 0119) the printer utilizing input digital image

data comprised of an array of pixels and wherein each pixel is assigned a digital value

representing marking information (note page 2, paragraph 0028 and page 5, paragraph 0122) the

apparatus comprising a rendering circuit for defining each pixel as either a background pixel,

interior pixel, or an edge pixel (note page 2, paragraphs 0043-0046 and page 5, paragraph 0122

and page 9, paragraph 0201) and reassigning the digital value of one or more of the edge pixels

or interior pixels independently in order to reduce toner consumption of the printer (note page 5,

paragraph 0125-0127, and 0129).

Regarding claim 17 Matsukubo et al disclose: An apparatus in accordance with claim 16,

wherein the digital image data is binary (note page 5, paragraphs 0119&0121).

Regarding claim 18 Matsukubo et al disclose: An apparatus in accordance with claim 16, wherein the digital image data is a multi-bit (note paragraphs 0119 and 0121).

Regarding claim 19 Matsukubo et al disclose: An apparatus in accordance with claim 16, wherein reassigning comprises increasing the value of edge pixels with respect to interior pixels (note page 9, paragraph 0201 and page 5, paragraphs 0127&0129).

Regarding claim 20 Matsukubo et al disclose: An apparatus in accordance with claim 16, wherein reassigning step comprises decreasing the value of edge pixels with respect to interior pixels (note page 9, paragraph 0201).

Regarding claim 21 Matsukubo et al disclose: An apparatus in accordance with claim 16, wherein the rendering circuit further comprises performing the defining and reassigning steps two or more times (note page 5, paragraphs 0126-0128).

Regarding claim 22 Matsukubo et al disclose: An apparatus in accordance with claim 16, wherein reassigning comprises reassigning multiple interior pixel values (note page 5, paragraphs 0119 and 0121).

Regarding claim 23 Matsukubo et al disclose: An apparatus for altering the appearance of an input digital image when printed utilizing a printer (note page 5, paragraph 0119) comprising: a raster image processor (note page 2, paragraph 0007, lines 22-28) for converting the image into a digital bitmap comprised of an array of pixels wherein each pixel is assigned a digital value representing marking information (note page 2, paragraph 0028, and page 1 paragraph 0007, also page 10 paragraph 0228) a rendering circuit for defining each pixel as either a background pixel, interior pixel, or an edge pixel (note page 2, paragraphs 0043-0046 and page 5, paragraph 0122) and, reassigning the digital value of one or more edge pixels or interior pixels to lower values

independently in order to reduce toner consumption (note page 5, paragraph 0125-0129).

Regarding claim 24 Matsukubo et al disclose: An apparatus in accordance with claim 23, wherein converting comprises converting the image to a binary digital bitmap and the reassigning step comprises reassigning the binary digital values to multi-bit digital values (note page 5, paragraphs 0119-0121).

Regarding claim 25 Matsukubo et al disclose: An apparatus in accordance with claim 23, wherein converting comprises converting the image to a multi-bit digital bitmap and reassigning comprises reassigning the binary digital values to multi-bit digital values (note page 5, paragraphs 0119-0121).

Regarding claim 26 Matsukubo et al disclose: An apparatus in accordance with claim 23, wherein reassigning comprises increasing the value of edge pixels with respect to interior pixels (note page 9, paragraph 0201).

Regarding claim 27 Matsukubo et al disclose: An apparatus in accordance with claim 23, wherein reassigning comprises decreasing the value of edge pixels with respect to interior pixels (note page 5, paragraph 0128).

Regarding claim 28 Matsukubo et al disclose: An apparatus in accordance with claim 23, wherein the rendering circuit performs performing the defining and reassigning two or more times (note page 5, paragraphs 0126-0128).

Regarding claim 29 Matsukubo et al disclose: An apparatus in accordance with claim 23, wherein reassigning comprises reassigning multiple interior pixel values (note page 5, paragraph 0127, 0129).

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

Claims 1-15 are rejected under *35 U.S.C. 101* as not falling within one of the four statutory

categories of invention.

While the claims recite a series of steps of cats to be performed, a statutory "process" under 35

U.S.C 101 must (1) b tied to another statutory category (such as an article or material) to a

different state of thing (Reference the may 15,, 2008, memorandum issued by Deputy

commissioner for patent Examiner policy, John J Love, titled "Clarification of processes" under

35 U.S.C. 101"- Publicly available at USPTO, GOV, "memorandum to examining corp.").

This instant claims neither transform underlying subject matter nor positively tie to another

statutory category that accomplishes the claimed method steps, and therefore do not qualify as a

statutory process. In order for a process to be "tied" to another statutory category, the structure of

another statutory category should be positively recited in a step of steps significant to the basic

inventive concept, and NOT just in association with statements of intended use or purpose,

Insignificant pre or post solution activity, or implicitly.

CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Saeid Ebrahimi-dehKordy whose telephone number is 571-272-

7462. The examiner can normally be reached on Mon-Fri,8:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Saeid Ebrahimi-dehKordy/
Primary Examiner, Art Unit 2625
November 27, 2008